<u>Remarks</u>

Claims 1-20 are pending.

Claims 1 – 3, 5 – 16 and 18 - 20 stand rejected under 35 U.S.C. §102(e) over U.S. Patent 5,869,819 (Knowles). The section 102 rejection means that the Examiner is asserting that Knowles discloses *every single* claim limitation – either expressly or inherently. This assertion is clearly incorrect and undermines the rejection.

Claim 1 is listed bellow:

1. An information delivery system, comprising:

a postage system configured to apply postage and a network address to objects in a postage field on the objects wherein the postage field comprises an area reserved on the objects for the postage and wherein the objects are delivered to users; and

a server system configured to receive a first message over the Internet from one of the users, wherein the first message is addressed to the network address, process the first message to retrieve information, and transfer the information in a second message over the Internet to the one of the users.

Claim 1 requires a system that applies <u>postage</u> and a <u>network address</u> to the <u>postage field</u> on an object. The current Office Action does not state where Knowles expressly teaches these missing limitations. Instead the Office Action states the following.

> "Knowles teaches in figure 12A element 57A that a
> URL code is used in as the equivalent of a network
> address. The URL code can be placed anywhere with in
> the package and it can function as postage."

Element 57A of Fig. 12A is a URL code, but it is *not* postage and does not function as postage. The Application clearly defines "postage" in an industry-standard manner as the amount of money that has been paid for the package to be delivered. The URL code in Knowles is not postage and does not function as postage. The examiner has made a completely unsupported statement that the URL "can function as postage". Applicant respectfully requests that the examiner indicate where

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Knowles teaches that the URL can function as postage, otherwise the examiner must withdraw this rejection.

The current Office Action has failed to show where Knowles expressly discloses the placement of a network address in the postage field. The examiner states:

> "Therefore, it is inherent that the URL code can be placed in any location on the object."

The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Knowles does <u>not</u> teach or suggest placing the bar-encoded URL in the postage field of the package. First, Knowles teaches away from this claim limitation by teaching that the bar-encoded URL be placed "randomly" on the package. (See Knowles column 23, lines 7-9). Second, random placement of the bar-encoded URL *in the postage field* would cause the bar-encoded URL to improperly overwrite the postage. Neither Knowles nor one skilled in the art would allow a randomly placed barcode to overwrite the postage.

Knowles does not discuss postage or postage fields. It is improper to solve this problem by using hindsight reasoning to improperly attribute the invention to Knowles. Knowles places bar-encoded URLs on packages that might have a postage field, but Knowles does not teach or suggest placing the bar-encoded URL in the postage field, and in fact, Knowles teaches away from placing the bar-encoded URL in the postage field. The placement of a URL in the postage field should be attributed to Applicant.

The same reasoning applies to claims 2-20.

Claims 4 and 17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,869,819 (Knowles) in view of U.S. Patent 6,010,156 (Block). Because Knowles is shown hereinabove as not including all of the limitations of claim 1 or of claim 15, the combination of Knowles in view of Block does not

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disclose all the limitations of claim 4 or 17. Accordingly, the Applicant believes that the rejection under 35 U.S.C. 103 has been overcome.

In recent responses, Applicant noted several other claim limitations that are missing from Knowles:

- The use of the network address to obtain information by the user who receives delivery of the object.

- The application of postage based on weight information

- The generation of a postmark that includes a network address.

The current Office Action does not state where these limitations are disclosed in Knowles.

Applicants submit that there are numerous additional reasons in support of patentability, but that such reasons are moot in light of the above remarks and are omitted in the interests of brevity. Applicant respectfully requests allowance of claims 1-20.

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